SINGAPORE REPORTS.

TAN LEE KENG AND ANOR. v. REX.

[App. Crim. Juris. (Evans, J.) June 26, 1950]

[Singapore — Magistrate's Appeal No. 52 of 1950]

Merchandise Marks Ordinance (Cap. 157), s. 11 — Definition of Trade Mark — Whether unregistered trade mark comes within the definition.

In this case the appellants appealed against their convictions under section 11 of the Merchandise Marks Ordinance (Cap. 157). It was argued on appeal that the section applies only to protected trade marks within the meaning of the definition in the Ordinance and as the trade mark in this case was not registered, it was not so protected and therefore the conviction was wrong.

Held, that the trade mark in this case, not being registered did not come within the definition of a trade mark in the Ordinance, and therefore the convictions must be quashed.

Cases referred to:—

(1) *Lever v. Goodwin* (1887) 36 Ch. D. 2.

(2) *Powell v. Birmingham Vinegar Brewery Co.* (1896) 2 Ch. 67.

(3) *Millington v. Fox* 3 My. & Cr. 338.

(4) *The Leather Cloth Co. Ltd. v. The American Leather Cloth Co. Ltd.* 4 De G. J. & S. 142.

(5) *Barber v. Manico* (1893) 10 R.P.C. 93.

MAGISTRATE'S APPEAL.

Mark Morrison for the appellants.

L. A. J. Smith for the Crown.

Cur. Adv. Vult.

Evans, J.: — The two appellants are appealing against convictions under section 11 of the Merchandise Marks Ordinance (Cap. 157); the first on a point of law and on the facts and the second on the same point of law only. The point taken is that the section applies to "protected" Trade Marks only, and that there is no evidence that the Trade Mark in question here is "protected".

The Ordinance defines Trade Mark as follows:—

'"Trade Mark" means a trade mark which is protected by law in this Colony, and includes any trade mark registered in the register of trade marks kept under the Trade Marks Act, 1905, and any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of section 91 of the Patents and Designs Act, 1907, are under Order of the King in Council for the time being applicable;'

When this Ordinance was passed there was no local registration of Trade Marks, but in 1938 an Ordinance (No. 38) was passed for that purpose, and that Ordinance, by section 56, following the English Acts, took away the action for infringement of a trade mark from any trade mark not duly registered. The appellants argue that this trade mark, not being registered, is not protected within the meaning of the definition to the Merchandise Marks Ordinance. No registration in the Colony or elsewhere was proved.

The principal protection of a trade mark is this action for infringement, and it might therefore seem that this trade mark being deprived of its best shield and defence is indeed unprotected. The prosecution reply that a passing off action might still be brought and, for that reason, the trade mark may yet be said to be "protected". It is necessary therefore to examine the nature of this passing off action on which the prosecution rely.

In patent cases it is usual to plead the user by the defendant of plaintiff's mark basing the claim on infringement and then to add a second claim based on passing off. This, however, cannot be conclusive; it merely indicates that the passing off action is an action of a wider nature which may achieve much the same results. The infringement action is based on the owner's property in the mark and his right to its exclusive use. The passing off action on the other hand is akin to fraud, three parties are in contemplation the person whose acts are impugned, the purchaser who has bought goods of that person on the supposition that they were goods made, or selected, by another, and the person (in some cases the trade mark owner) whose goods, the goods bought, were thought to be, and whose trade is injured by the first person's acts. Thus in *Lever v. Goodwin*[1] Chitty J. said:—

"The law applicable to the case is plain, it is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods which are being offered for sale are the goods, not of the person who made them, but of some other manufacturer. That is a case merely between the buyer and seller. Then comes the case where the manufacturer, by devices which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he, the manufacturer, is putting on the market are the goods of some other maker. Here, generally speaking, a double fraud is committed; first, there is the fraud which is perpetrated on the ultimate buyer; and, secondly, there is fraud perpetrated on the other manufacturer, who loses part of his trade. In this class of cases the trade is seldom deceived, the retail dealers know from whom they are buying, and if there is a fraudulent device they are rarely taken in by it. But in such a case the manufacturer puts an instrument of fraud into their hands. Now it has been said more than once in this case, that the manufacturer ought not to be held liable for the fraud of the ultimate seller — that is, the shopkeeper or the shopkeeper's assistant; but that is not the true view of the case. The question which I have to try is whether the defendants have or have not knowingly put into the hands of the retail dealers the means of deceiving the ultimate purchasers."

In *Powell v. Birmingham Vinegar Brewery Company*[2] Lindley L.J. said, speaking of the branching of the action for infringement from that of passing off :—

"Before there was any legislation on the subject of trade-marks it was well settled that when any one adopted a mark so closely resembling the trade-mark of the plaintiff as to be likely to be mistaken for it, the plaintiff was entitled to an injunction to restrain the use of such mark. Fraud on the public to the detriment of the plaintiff was the foundation of the right to damages at common law: per Lord Blackburn in **Singer Manufacturing Co. v. Loog**; but as long ago as 1833 it was decided in **Millington v. Fox** that intentional deceit was not essential to warrant the Court in granting an injunction. The Court will interfere to protect a plaintiff if ordinary or unwary purchasers are likely to be misled and to mistake the defendant's goods for the plaintiff's. Nothing can be more emphatic on this point than Lord Cairns's judgment in **Singer Manufacturing Co. v. Wilson.**"

when Lord Cairns said :—

"I have never known any serious doubt entertained on this subject since the case of **Millington v. Fox,** and I may refer to the observations of Lord Hatherley, then Vice-Chancellor, in the case of **Welch v. Knott**: "That the Defendant would not be entitled to use the Plaintiff's bottles in such a manner as in fact to mislead the public, although there might be no intention on his part to mislead, is clear." In **Millington v. Fox,** Lord Cottenham felt satisfied that in using the Plaintiffs' trade-marks the Defendants had no intention to mislead the public; yet inasmuch as the public were in fact misled, he held that the Plaintiffs were entitled to a perpetual injunction. It was not sufficient for the Defendants to say that they used the marks in ignorance of their being the Plaintiffs' trade-marks. How far that doctrine is capable of being reconciled with cases at law in which the scienter has been held to be essential in order to enable the Plaintiff to recover (that is, to recover damages) it is not material to consider. In this Court the rule is clear, as laid down in **Millington v. Fox.**"

In this case of *Millington v. Fox*[3] Lord Cottenham refers to the trader's property in his mark. After 1860 reports are frequent of cases brought to protect that property, which are actions for infringement of unregistered marks. In *The Leather Cloth Company Limited v. The American Leather Cloth Company Limited*[4] Lord Westbury L.C. reviews the discussion as to the basis of these actions and concludes :—

"It is correct to say that there is no exclusive ownership of the symbols which constitute a trade-mark apart from the use or application of them; but the word "trade-mark" is the designation of these marks or symbols as and when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called property. The true principle therefore would seem to be, that the jurisdiction of the Court in the protection given to trade-marks rests upon property, and that the Court interferes by injunction, because that is the only mode by which property of this description can be effectually protected."

Similar actions for infringement might have been brought here for the protection of unregistered marks before 1938, but they are no longer available. Such actions are designed to protect the plaintiff's property in a mark used in connection with certain goods. The passing off action on the other hand may be brought, as in *Powell v. Birmingham Vinegar Brewery Company* above, where the mark used and copied has been removed from the register of trade marks, or, as in *Barber v. Manico*[5] where the mark itself was held not to be misleading, and the defendant was restrained in respect of that properly registered mark used on similar, if not the same, goods, which mark, however, caused a name which might be misleading to be applied to defendant's goods. This action is, therefore, quite independent of the mark, which is only relevant as possibly contributing to deception. The action for infringement aims directly at protecting the property in the mark itself and is brought to stop the wrongful use of that mark, but the passing off action is for protection of the plaintiff's trade which the mark may be used to promote. The trade mark may derive some protection from a passing off action, but it might equally do so from an action of deceit or from a defence of fraud. The protection of the trade mark is not the object of either of these two latter actions.

The section under which appellants were prosecuted is a penal section, and must be strictly construed. I think it would be giving a forced, and, indeed, an improper meaning, to the definition cited to say that it includes any mark because a passing off action might protect it. In my opinion therefore the appeals must succeed and the conviction herein is quashed.

Appeals allowed.

In re TEO SOO PIAH DECEASED; TEO LYE SENG v. WEE GUAT LAN (w) AND ANOR.

[Orig. Civ. Juris. (Evans, J.) May 31, 1950]

[Singapore — Originating Summons No. 34 of 1950]

Will — Whether term "children" in will includes adopted children — Costs.

In this Originating Summons the plaintiff asked for determination of the question whether "children" in clause 2 of the will of Teo Soo Piah (deceased) includes adopted children. Clause 2 of the will read as follows: "I direct my trustees to stand possessed of all my property of whatsoever nature and wheresoever situate upon trust to keep the same until my youngest son Teo Beng Teng attains the age of thirty (30 years) and in the meantime to collect the income therefrom and after payment of the monthly allowances and for the maintenance and upkeep of my children to invest the same as hereinafter mentioned".

Held, (1) that there is nothing in the will to indicate that the word "children" has an extended meaning and therefore the word must be taken to include legitimate children only; (2) that the general rule that a legatee whose claim is dismissed is not entitled to costs must be applied in this case and therefore the costs of the application must be paid by the applicant.

Cases referred to :—

(1) *In re Yeo Soo Theam deceased* (1938) M.L.J. 2.